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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/705,500 11/03/00 RECIPON

H DEX-0087

EXAMINER

HM12/0925

KATHLEEN A TYRRELL
LIICATA & TRYRELL P C
66 E MAIN STREET
MARLTON NJ 08053

CANELLA, K

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

09/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/705,500

Applicant(s)

Recipon et al

Examiner

Karen Can Ila

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-- Th MAILING DATE of this communication app ars on the cover sh et with the correspond nce address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 30 days MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the applica
- 4a) Of the above, claim(s) _____ is/are withdrawn from considera
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claims 1-14 are subject to restriction and/or election requirem

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- *See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

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DETAILED ACTION

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-5, 7, 8, 6 in part and 12 in part, drawn to methods of diagnosing and monitoring cancer in a patient comprising assaying for Lng108, and methods of identifying potential agents useful in the imaging of cancer comprising assaying for the ability of a molecule to bind to Lng108, classified in class 435, subclass 7.23 and class 436, subclasses 64, 501, 813 and 815. Claims 6 and 12 will be examined with this group to the extent that they read on imaging cancer.
 - II. Claims 9-11, 6 in part and 12 in part, drawn to methods of treating cancer comprising administering an antibody which binds to Lng108 or a molecule which downregulates expression or activity of Lng108 and methods of identifying potential agents for use in treating cancer which decrease the expression or activity of Lng108, classified, for example, in class 514, subclass 44 and class 530, subclass 387.7 and class 435, subclasses 6 and 7.23. Claims 6 and 12 will be examined with this group to the extent that they read on imaging cancer.
 - III. Claims 13 and 14, drawn to a method for inducing an immune response comprising the delivery of an immunogenically stimulatory amount of Lng108 and a vaccine for treating cancer comprising and immunogenically stimulating amount of Lng108, classified in class 424, subclass 277.1 and class 530, subclasses 350 and 828.
2. The inventions are distinct, each from the other because of the following reasons:

The methods of Groups I, II and III differ in the method objectives, method steps and parameters and in the reagents used. For instance, a method for the imaging or diagnosis of

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cancer in the Invention of Group I would require a radio labeled antibody that would bind to an available epitope of Lng108 accessible on the cancer cells. No cytotoxic reaction with said cancer cells or limitation of the activity of Lng108 is required of the binding antibody. For the Invention of Group II, an antibody which is antagonistic to the Lng108 target is required to limit the activity of Lng108, or an antisense DNA to the polynucleotides encoding Lng108 or a polynucleotide encoding an intrabody which would bind to Lng108 would be necessary to limit the expression or activity of Lng108. The invention of Group II encompasses a method of upregulating the immune response to Lng108 comprising the administration of Lng108 protein. Upregulation of the immune response to recognize the Lng108 antigen within the patient is not a part of inventions I or II. Thus the method objectives and reagents used to attain the method objectives are distinct for Inventions I-III.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter and because the searches required for the groups are not co-extensive, restriction for examination purposes as indicated is proper.

3. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

September 12, 2001


ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600